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• Comments:

In re Application of: GEWEHR et al.

Serial No.: 10/616,950

Attorney Docket: AM 200040

Confirmation No.: 2161

Filing Date: 07/11/2003

Attachments: Brief on Appeal
Form PTO-2038

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AUG 28 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION

OF: GEWEHR ET AL.
 SERIAL NO. 10/616,950
 FILED: JULY 11, 2003
 FOR: FUNGICIDAL USE

DOCKET NO.: AM200040
 CONFIRMATION NO.: 2161
 GROUP ART UNIT: 1616
 EXAMINER: SABIHA N. QAZI

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Honorable Commissioner
 for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

1. ☐ NOTICE OF APPEAL: Applicant hereby appeals to the Board of Appeals from the decision dated -/- of the Primary Examiner finally rejecting Claims -/-.
2. ☒ BRIEF ON APPEAL in this application is transmitted herewith.
☐ Applicants hereby request an Oral Hearing.
3. ☒ Applicants hereby request entry of their timely reply dated June 28, 2006 for purposes of appeal.
4. ☐ Applicants hereby petition for a -/- month extension of time under 37 C.F.R. §1.136(a).
☐ A petition for a -/- month extension of time including the requisite fee of -/- has been submitted along with the reply under 37 C.F.R. §1.116 dated -/-.
5. ☒ The following fee(s) in the total amount of \$500.00- is(are) paid herewith by credit card (Form PTO-2038 enclosed):
☒ The \$ 500.00 fee required under 37 C.F.R. §41.20(b)(2).
☐ The -/- fee required under 37 C.F.R. §41.20(b)(3).
☐ The -/- fee required under 37 C.F.R. §1.17(a).
☐ A fee is not required (Fee paid in prior appeal).
6. ☒ The Commissioner is hereby authorized to charge any fee which may be further required, or credit any over payment, to Deposit Account No. 14.1437. A duplicate copy of this sheet is attached.

Respectfully submitted,

NOVAK DRUCE DELUCA & QUIGG

[Signature]
 James Remenick
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and Trademarks, Alexandria, Va 22313-1450,
on: August 28, 2006Date of transmission/deposit
Signature: [Signature]Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

This is an appeal from the Examiner rejection of Claims 1, 2, 4 and 5, dated February 28, 2006.
Claims 1, 2, 4 and 5 are currently pending.TABLE OF CONTENTSReal Party in Interest
Related Appeals and Interferences
Status of the Claims
Status of the Amendments
Summary of the Claimed Subject Matter
Ground(s) of Rejection to be Reviewed
Argument(s)
Conclusion
Claims Appendix
Evidence Appendix
Related Proceedings Appendix -none-

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REAL PARTY IN INTEREST

The real party in interest is BASF Aktiengesellschaft, 67056 Ludwigshafen, Germany.

RELATED APPEALS AND INTERFERENCES

To the best of the undersigned's knowledge, there are no related appeals or interferences within the meaning of 37 C.F.R. §41.37(c)(1)(ii).

STATUS OF THE CLAIMS

Claims 1, 2, 4 and 5 are currently pending in the application. A copy of these claims is found in the attached Appendix. The current status of those claims is as follows:

- Claims 1, 2, 4 and 5 stand rejected;
- Claim 3 was canceled in a preliminary amendment submitted upon filing of the application;
- No Claim(s) stand(s) allowed;
- No Claim(s) stand(s) objected to; and
- No Claim(s) stand(s) withdrawn from consideration.

A copy of the claims currently pending in the application is provided in Appendix I of this paper.

STATUS OF THE AMENDMENTS

Claim 1 was amended in appellants' reply under 37 C.F.R. §1.111 dated June 10, 2005. No further amendments have been filed in this application subsequent to the rejection dated February 28, 2006.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellants' invention relates to a method for controlling eye spot or stem break in crop plants ie. a fungal disease which is caused by the fungus *Pseudocercospora herpotrichoides*. The fungus *Pseudocercospora herpotrichoides* is a plant pathogen which grows primarily in the plant tissue,¹⁾ and the fungal disease affects mainly the stem of the crop plant.²⁾

Appellants' method entails applying to the crop plants an effective amount of a benzophenone of formula (I)

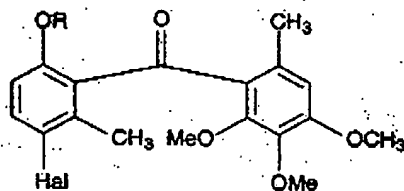
1) Cf. page 2/8, lines 23 to 26, of Dr. Stierl's Declaration dated January 16, 2006.

2) Cf. page 1, indicated lines 36 to 38, of the application.

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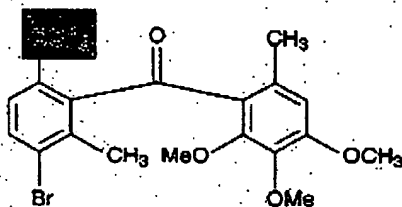


in which

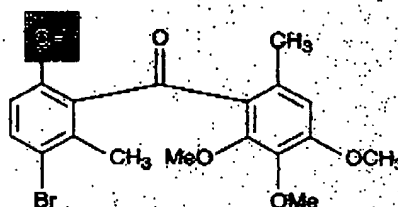
R represents C₁-C₄-alkyl andHal is fluorine, chlorine or bromine.³⁾

In particular embodiments of appellants' invention the compound of formula (I) which is applied is 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone and/or the crop plants to which the compound (I) is applied are wheat and barley plants.⁴⁾

Appellants' method is particular in that the compounds of formula (I) which are referenced in appellants' claims are distinctly better suited to control the fungus than corresponding compounds which differ structurally only in that the group represented in formula (I) by R is replaced by hydrogen.⁵⁾ The distinct advantage of appellants' method was shown in side-by-side investigations into the suitability of the following benzophenone compounds



Example I.1 of
application Serial No. 10/616,950



Comparative Compound

which yielded the data compiled in the following table:

Benzophenone Compound	Application Rate [ppm]	Fungal Attack [%]
Example I.1	16	19
Comparative Compound	16	56
untreated control		90

Accordingly, appellants' method reduced the fungal attack from 90% of an untreated control to only 19% fungal attack, whereas the comparative method in which the hydrogen substituted Comparative Compound was employed at the same application rate did not even reduce the fungal attack by half.

3) Cf. Claim 1, as well as page 1, indicated lines 4 to 21 and 34 to 39, and page 9, indicated line 35, to page 10, indicated line 10, of the application.

4) Cf. Claims 2, 4 and 5, as well as page 1, indicated lines 38 and 39, page 1, indicated line 41, to page 2, indicated line 14, and page 9, indicated line 35, to page 10, indicated line 10, of the application.

5) Cf. Dr. Stierl's Declaration dated June 06, 2005.

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Appellants' method is also particular in that the compounds (I) are distinctly more effective in the control of the fungus *Pseudocercospora herpotrichoides* than in the control of other plant pathogens which grow primarily in the plant tissue.⁶⁾ These particular effects were shown in side-by-side investigations into the effectivity of the compound (I.1) against the fungus *Pseudocercospora herpotrichoides* (PSDCHE P1) and against eight other fungal diseases which are caused by the following comparative fungi, all of which also mainly grow in the plant tissue:

Alternaria solani	Early blight	ALTESO P1
Botrytis cinera	Grey mold	BOTRCI P1
Fusarium culmorum	Culm rot	FUSACU P1
Phytophthora infestans	Late blight	PHYTIN P1
Plasmopara viticola	Grape downy mildew	PLASVI P1
Puccinia recondite	Brown rust	PUCCRT K1
Pyricularia oryzae	Rice blast	PYRIOR P1
Pyrenophora teres	Net blotch	PYRNTE P1

When the compound (I.1) was applied in an amount of 250 ppm to control of the fungus *Pseudocercospora herpotrichoides* in accordance with appellants' method, the fungal attack was reduced from 90% of a control experiment to 0%. However, in the comparative methods in which the compound (I.1) was applied in the same amounts to control one of the other fungal diseases, no control of the fungi was achieved.⁷⁾

GROUND(S) OF REJECTION TO BE REVIEWED

- I. Whether the Examiner erred finding that the subject matter of appellants' Claims 1, 2, 4 and 5 was *prima facie* obvious under 35 U.S.C. §103(a) in light of the teaching of *Curtze et al.* (US-A 6,127,570).
- II. Whether the Examiner erred finding that the subject matter of appellants' Claims 1, 2, 4 and 5 was unpatentable under the judicially created doctrine of obviousness-type double patenting in light of Claims 1 to 5 of *Sieverding et al.* (US-A 6,696,497).

ARGUMENT(S)

I. The Examiner's conclusion that the subject matter of appellants' Claims 1, 2, 4 and 5 was unpatentable under 35 U.S.C. §103(a) in light of the teaching of *Curtze et al.* is, for the following rea-

6) Cf. Dr. Stierl's Declaration dated January 16, 2006.

7) Cf. Dr. Stierl's Declaration dated January 16, 2006, in particular page 7/8.

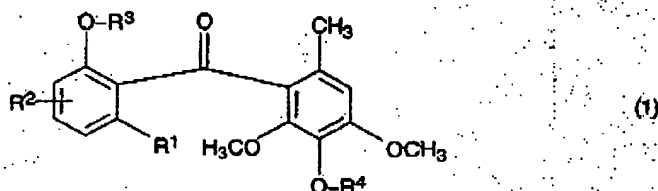
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sons, deemed to be in error.

The teaching of *Curtze et al.* pertains to certain 2-hydroxybenzophenone compounds which are represented by a formula (1)



Most notably, *Curtze et al.* require that the radical which is represented in formula (1) by R^3 denote a hydrogen atom or a protecting group.⁸⁾ *Curtze et al.* also explain that the expression protecting group "refers to a group which is easily cleaved off without affecting the alkoxy groups present" in the compound.⁹⁾ That is, the protecting group has to differ, on the one hand, from methyl groups as are present in the OCH_3 radicals depicted in formula (1). On the other hand, the protecting group has to differ from alkyl radicals which are represented by R^4 which is an optionally substituted alkyl group having up to 10 carbon atoms,¹⁰⁾ and the protecting group has to differ from alkyl radicals of alkoxy moieties which are represented by R^2 .¹¹⁾ Since the protective groups represented by R^3 of *Curtze et al.*'s compounds are to be cleavable without cleaving the other alkoxy groups which are present in the benzophenone of formula (1), the moiety R^3-O of *Curtze et al.*'s formula (1) cannot reasonably be deemed to represent a methoxy moiety or an alkoxy moiety having up to 10 carbon atoms which is optionally substituted. In fact, the teaching of *Curtze et al.* that the protective group which is represented by R^3 be cleavable without cleaving the other alkoxy groups which are present in the benzophenone of formula (1) conveys that alkyl moieties are unsuited as alternative radicals so that a motivation to replace the hydrogen or the protective group R^3 by alkyl is lacking.

The protective group represented by R^3 of *Curtze et al.*'s formula (1) is clearly different from alkyl groups. The compounds (1) which are employed in accordance with appellants' method are, in contrast to the benzophenones (1) of *Curtze et al.*, required to carry a moiety OR in the corresponding position in which R is C_1-C_4 -alkyl. Hence, the compounds which are required to practice the method disclosed and claimed by appellants are neither within the realm of the benzophenones (1) of *Curtze et al.* nor suggested by the referenced teaching. The Examiner argued that:¹²⁾

CURTZE et al. teaches fungicidal substituted 2-hydroxybenzophenone compounds, which embrace the presently claimed invention.

8) Cf. col. 1, indicated lines 45 to 67, of US 6,127,570.

9) Cf. col. 3, indicated lines 7 to 16, of US 6,127,570. Cf. also col. 3, indicated lines 47 to 50, and col. 4, indicated lines 44 to 45, of US 6,127,570.

10) Cf. col. 2, indicated line 1 and indicated lines 52 to 59, of US 6,127,570.

11) Cf. col. 1, indicated lines 62 and 63, and col. 2, indicated lines 52 to 59, of US 6,127,570.

12) Office action dated February 28, 2006, page 5, lines 17 and 18.

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and that:¹³⁾

Instant claims differ from the prior art in claiming a narrower scope of the prior art's invention. The Examiner's respective position is deemed to be in error in light of the structural distinction between appellants' formula (I) and *Curtze et al.*'s formula (1). Moreover, the teaching of *Curtze et al.* specifically conveys that it is desired that the moiety R³ be cleaved without affecting alkoxy groups in the molecule after the compound has been applied to the plants.¹⁴⁾ As such, the teaching of *Curtze et al.* cannot be deemed to have motivated a person of ordinary skill in the art to replace the hydrogen or the cleavable protective group which is present in the benzophenones (1) by the C₁-C₄-alkyl group which is mandatory for appellants' formula (I), or by the methyl which takes the requisite position in the compound 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone.

The Examiner further argued:¹⁵⁾

One skilled in the art would have been motivated to prepare a method for controlling Pseudocercospora herpotrichoides in crop plants ... because the prior art teaches the control of fungus in crop plants through the use of benzophenone derivatives.

According to *Curtze et al.*, however, the benzophenones are useful for controlling:¹⁶⁾

especially ascomycetes, in particular powdery mildew diseases such as those caused by Blumeria (Erysiphe) graminis, Erysiphe cichoracearum, Podosphaera leucotricha, Uncinula necator and the like.

Dr. Stierl pointed out in his Declaration dated January 16, 2006, that the pathogens which are enumerated by *Curtze et al.* grow on the leaf surface and not primarily in the plant tissue.¹⁷⁾ Dr. Stierl also explained in said Declaration why the effectivity of one group of benzophenones such as the compounds (1) of *Curtze et al.* against diseases which grow on the surface of the plants cannot be deemed to suggest or imply the general suitability of another group of benzophenones, namely the compounds represented by appellants' formula (I), for fungal diseases which grow primarily in the plant tissue, and that the teaching of *Curtze et al.* is, therefore, even less suited to suggest appellants' method for controlling *Pseudocercospora herpotrichoides* in crop plants by applying an effective amount of the compounds of appellants' formula (I).¹⁸⁾

Obviousness within the meaning of Section 103(a) requires that the prior art provide for some teaching or suggestion which would have motivated a person of ordinary skill in the art to do what

13) Office action dated February 28, 2006, page 6, lines 1 and 2.

14) Cf. col. 3, indicated lines 17 to 19, of US 6,127,570.

15) Office action dated February 28, 2006, page 6, lines 3 to 6.

16) Cf. col. 3, indicated line 65, to col. 4, indicated line 1, of US 6,127,570.

17) Cf. Dr. Stierl's Declaration dated January 16, 2006, page 2/8, lines 15 to 30.

18) Cf. Dr. Stierl's Declaration dated January 16, 2006, page 2/8, line 22, to page 3/8, line 33.

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the applicant has done.¹⁹⁾ For obviousness within the meaning of Section 103(a) it is also necessary that the prior art reference teach or suggest all of the elements which characterize the claimed invention. In light of the foregoing, the teaching of *Curtze et al.* cannot reasonably be deemed to motivate a person of ordinary skill in the art to effect the structural changes in the benzophenone compounds which are necessary to arrive at appellants' formula (I) based on the structures (1) of *Curtze et al.* and can also not be deemed to suggest or imply any particular properties of structurally altered compounds as concerns the control of *Pseudocercospora herpotrichoides*.

The Examiner criticized that²⁰⁾

In absence of any criticality and/or unexpected results, the presently claimed invention is considered prima facie obvious to one skilled in the art.

The respective criticism is not deemed to be justified. Appellants have, on the one hand, shown that the method as claimed is distinctly and unexpectedly more successful than a comparative method in which a hydrogen-substituted benzophenone (1) according to the teaching of *Curtze et al.* is employed.²¹⁾ The respective data are deemed to clearly corroborate the criticality of the structural requirements regarding the compounds which is employed in the method disclosed and claimed by appellants. On the other hand, appellants have shown that the nature of the plant pathogen is a critical element of appellants' method.²²⁾ MPEP §2144.08(III) points out

A determination under 35 U.S.C. 103 should rest on all the evidence and should not be influenced by any earlier conclusion. See, e.g., Piasecki, 745 F.2d at 1472-73, 223 USPQ at 788;²³⁾ In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Thus, once the applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. See, e.g., Piasecki, 745 F.2d at 1472, 223 USPQ at 788; Eli Lilly, 902 F.2d at 945, 14 USPQ2d at 1743.

The Examiner's criticism indicates that the Examiner's conclusion that appellants' method is unpatentable under Section 103(a) was reached without due consideration of the evidence which had been presented by appellants.

II. The Examiner's conclusion that the subject matter of appellants' Claims 1, 2, 4 and 5 was unpatentable under the judicially created doctrine of obviousness-type double patenting in light of

19) Cf. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

20) Office action dated February 28, 2006, page 6, lines 10 and 11.

21) Cf. Dr. Stierl's Declaration dated June 06, 2005.

22) Cf. Dr. Stierl's Declaration dated January 16, 2006.

23) *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

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Claims 1 to 5 of Sieverding et al. is, for the following reasons, deemed to be in error.

The claims of *Sieverding et al.* relate to a fungicidal composition²⁴⁾ which comprises synergistically effective amounts of

(a) a benzophenone which generically encompasses applicants' compounds (I) and the compound 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone, and

(b) a valinamide compound represented by a formula (II),

and which is effective against a broad variety of phytopathogenic fungi²⁵⁾ in particular on dicotyledonous plants such as grapes, tobacco, potato, tomato, fruit crops, oil seed crops, vegetables and ornamentals, and also on monocotyledonous crops.²⁶⁾ The Examiner argued:²⁷⁾

The instant claims differ from the claims of the cited US Patents in that these US Patents cite specific second components for the fungicidal composition. In the instant claims, a specific second ingredient has not been named. However, the term "comprising" allows for a second ingredient to be added.

The rationale underlying the Examiner's argument is deemed to be erroneous in that it fails to appreciate appellants' requirement that "effective amounts of benzophenones of the formula I" be employed in the method. Appellants' respective requirement cannot reasonably be considered as being synonymous with the requirement of *Sieverding et al.* for "synergistically effective amounts of ... a benzophenone ... and a valinamide ..." ²⁸⁾ *Sieverding et al.* describe investigations into the effectivity of the referenced benzophenones and the valineamides the results of which are compiled in tables 1 and 2 of the reference. ²⁹⁾ The investigated benzophenone is employed in these investigations at application rates at which it exhibits no control, corresponding to an observed efficacy of 0%, or it exhibits only a negligible control corresponding to an observed efficacy of 1% to 6%. A review of the data pertaining to the tests in which *Sieverding et al.* applied a combination of the benzophenone and the valinamide reveals that synergistically effective amounts of the benzophenone and the valinamide do not correlate to effective amounts of the benzophenone. The teaching, or the subject matter of Claims 1 to 5, of *Sieverding et al.* accordingly differs from the method which is defined in appellants' claims, inter alia, because the fungicidal effect which is achieved in accordance with *Sieverding et al.*'s teaching or claims is due to an application of a combination of synergistic amounts of two different compounds, whereas appellants' claims require that *Pseudocercospora herpotri-*

24) Cf. col. 1, indicated lines 7 to 65, of US 6,696,497.

25) Cf. col. 6, indicated lines 10 to 24, of US 6,696,497.

26) Cf. col. 6, indicated lines 25 to 29, of US 6,696,497.

27) Office action of February 28, 2006, page 4, lines 6 to 9.

28) Cf. e.g. Claim 1, col. 12, indicated lines 25 to 50, of US 6,696,497.

29) Cf. col. 11, indicated lines 24 to 49, and col. 11, indicated line 57, to col. 12, indicated line 23, of US 6,696,497.

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choides be controlled by application of effective amounts of the compound represented by appellants' formula (I).

As regards the fungicidal effectivity, *Sieverding et al.* explain that:³⁰⁾

The mixture according to the invention may be preferably applied for controlling phytopathogenic fungi of the genera:

Achyta, Alternaria, Balansia, Bipolaris, Blumeria, Botrytis, Cercospora, Cochliobolus, Curvularia, Cylindrocladium, Drechslera, Entyloma, Erysiphe, Fusarium, Gaeumannomyces, Gerlachia, Gibberella, Guignardia, Leptosphaeria, Magnaporthe, Monilinia, Mucor, Mycosphaerella, Myrothecium, Nigrospora, Peronospora, Phoma, Phytophthora, Podosphaera, Plasmopara, Pseudoperonospora, Pseudocercospora, Puccinia, Pyrenophora, Pyricularia, Pythium, Rhizoctonia, Rhizopus, Rhynchosporium, Sarocladium, Sclerophthora, Sclerotinia, Sclerotium, Septoria, Tilletia, Uncinula, Ustilago, Ustilaginoidea, and Venturia, in particular the species Plasmopara viticola, Phytophthora sp., Pseudoperonospora sp., and Bremia sp.

The cited section clearly pertains to properties which are achieved when synergistically effective amounts of the benzophenone and the valinamide are employed and cannot reasonably be taken to suggest or imply that the benzophenone can be expected to exhibit suitable control of the fungi. Moreover, appellants have presented data regarding the effectivity of the compound (I.1)³¹⁾ in the control of the emphasized phytopathogenic fungi.³²⁾ No control was achieved when one of the underlined fungi was treated in side-by-side investigations with similar amounts of the compound (I.1). However, when the same amount of the compound (I.1) was applied to the fungus *Pseudocercospora herpotrichoides*, a complete control resulted. The respective investigations corroborate that appellants' method achieves particular and unobvious advantages.

The Examiner indicated that the rejection under the judicially created doctrine of obviousness-type double patenting was maintained because no disclaimer had been filed by appellants, and asserted that appellants had failed to reply to the Examiner's rejection.³³⁾

According to long-standing holdings of the Courts, a double patenting rejection of the obviousness type is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. §103, except that the reference underlying the double patenting rejection is not considered prior art. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guide-

30) Cf. col. 6, indicated lines 10 to 24, of US 6,696,497; emphasis added.

31) Compound (I.1) according to appellants' invention corresponds to the compound designated as "BP-4" by *Sieverding et al.*; cf. col. 4, indicated lines 59 and 60, of US 6,696,497.

32) Cf. Dr. Stierl's Declaration dated January 16, 2006.

33) Office action dated February 28, 2006, page 2, lines 10 and 11.

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lines for analysis of a 35 U.S.C. §103 obviousness determination.³⁴⁾ While the determination underlying the obviousness-type double patenting analysis is made with a view to the claimed invention rather than the disclosure of the reference underlying the obviousness-type double patenting rejection, the specification can always be used as a dictionary to learn the meaning of a term in the earlier claim.³⁵⁾ Also, those portions of the specification which provide support for the earlier claims may be examined and considered when addressing the issue of whether a claim in the application defines a variation of an earlier claimed invention.³⁶⁾ However, corresponding to a determination of obviousness under Section 103(a), it is the *invention as a whole* must be considered when an analysis of obviousness-type double patenting is made.³⁷⁾ Accordingly, a rejection under the judicially created doctrine of obviousness-type double patenting can not only be addressed by filing a terminal disclaimer. It is also possible to rebut the rejection by showing that the non-obviousness requirement of 35 U.S.C. §103 are met by the claimed invention. The Examiner's maintaining the respective rejection because appellants did not file a terminal disclaimer is, therefore, deemed to be in error.

It is also respectfully urged that the Examiner erred asserting that appellants had failed to address the respective rejection. Appellants presented arguments addressing the issue on pages 4 to 6 of their reply dated June 10, 2006, and on pages 2 and 3 of their submission dated January 19, 2006. Additionally, appellants reiterated their respective position on pages 6 to 9 of the reply dated June 28, 2006. The Examiner's position is, given the circumstances, not deemed to be well taken.

CONCLUSION

In light of the foregoing reasons and explanations as well as the explanations already presented by appellants in their papers dated June 10, 2005, January 19, 2006, and June 28, 2006,³⁸⁾ appellants respectfully urge that the Examiner's final rejection of Claims 1, 2, 4 and 5 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Curtze et al.*, and under the judicially created doctrine of obviousness-type double patenting as being unpatentable in light of Claims 1 to 5 of *Steverding et al.* was in error. It is therefore respectfully requested that the Examiner's respective rejections be reversed. Favorable action is solicited.

34) Cf. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Braat*, 837 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

35) Cf. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968).

36) Cf. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

37) Cf. *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977).

38) The respective papers are herewith incorporated by reference.

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GEWEHR et al.

AM200040

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOVAK DRUCE DELUCA & QUIGG

James R. Renick
Reg. No. 36,902

1300 Eye Street, N.W.
Suite 400 East Tower
Washington, D.C. 20005
(202) 639-0100

Encl.: CLAIMS APPENDIX (Appendix I)
EVIDENCE APPENDIX (Appendix II)
RELATED PROCEEDINGS APPENDIX (Appendix III)

JR/BAS

060828

- 11/14 -

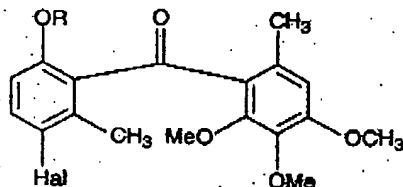
Serial No. 10/616,950

GEWEHR et al.

AM200040

APPENDIX ICLAIMS APPENDIX

1. A method for controlling *Pseudocercospora herpotrichoides* in crop plants comprising applying to said crop plants an effective amount of benzophenones of the formula I



in which

- R is C₁-C₄-alkyl and
Hal is fluorine, chlorine or bromine.
2. The method as claimed in claim 1, wherein an effective amount of 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone is applied.
4. A method for controlling *Pseudocercospora herpotrichoides* in wheat and barley comprising applying to said wheat and barley an effective amount of the benzophenones defined in claim 1.
5. The method as claimed in claim 4, wherein an effective amount of 5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxybenzophenone is applied.

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APPENDIX II.EVIDENCE APPENDIX

- 1) Dr. Stierl's Declaration dated January 16, 2006.

The respective declaration was presented with appellants' Submission under 37 C.F.R. §1.114, filed on January 19, 2006, and entry of appellants' Submission was confirmed by the Examiner in the Office action dated February 28, 2006, as indicated in the Status section (1) of the PTOL-326 form and on page 2, lines 2 to 6, of said Office action.

- 2) Dr. Stierl's Declaration dated June 06, 2005.

The respective declaration was presented with appellants' Reply under 37 C.F.R. §1.111, filed together with a Petition under 37 C.F.R. §1.137(b), dated June 10, 2006. The respective Petition was granted per Decision mailed on July 20, 2006, and entry of appellants' Reply was confirmed by the Examiner in the Office action dated August 19, 2005, as indicated in the Status section (1) of the PTOL-326 form and on page 2, lines 2 and 3, of said Office action.

6 JUN 2005 14:41

REITSTOETTER, KINZEBACH & PARTNER
149 021 002/110

NR. 2769 S. 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OP: GEWEHR ET AL.

SERIAL NO. 10/616,950

FILED: JULY 11, 2003

FOR: FUNGICIDAL USE

Honorable Commissioner
for Patents
P.O. Box 1480
Alexandria, VA 22313-1450

DECLARATION

I, Reinhard Srierl, Dr. agr., a citizen of the Federal Republic of Germany and residing at Jahnstr. 8, 67261 Freinsheim, Germany, hereby declare as follows:

I am fully trained agricultural engineer, having studied horticultural science at the Technical University of Munich-Weihenstephan, Germany, from 1987 to 1992;

From 1994 to 1999 I furthered my studies at the Institute of Plant Disease of the University of Bonn, and I was awarded my doctor's degree by the said university in 1999;

I joined BASF Aktiengesellschaft of 67056 Ludwigshafen, Germany, in 1998, and have since been working in the field of the characterization and screening of fungicidal substances, and am therefore fully conversant with the technical field to which the invention disclosed and claimed in application Serial No. 10/616,950 belongs.

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6. JUN. 2005 14:41

REITSTOETTER, KINZEBACH & PARTNER
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Serial No. 10/616,950

GEWEHR et al.

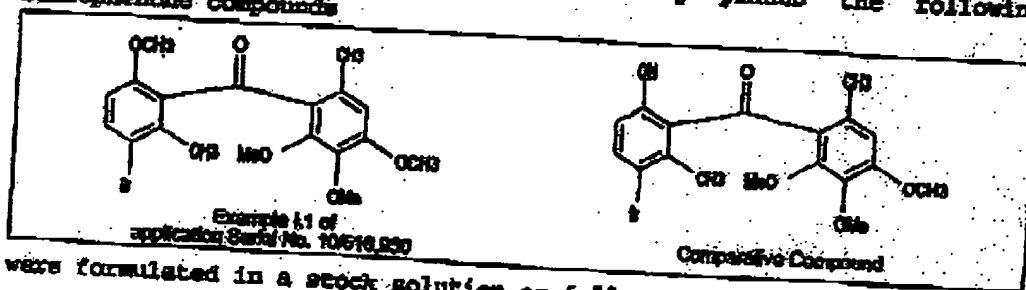
AD220040

I have studied the record of application Serial No. 10/616,950, and particularly the Office action mailed on September 29, 2004, and the prior art applied by the Examiner, in particular the teaching of Curtze et al. (US 6,127,570), the teachings of Cotter et al. (US 6,521,626 and US 6,734,202), and the teaching of Sievarding et al. (US 6,896,497).

It is my understanding that the Examiner contends that the particular features of the benzophenones which are represented by formula (I) of application Serial No. 10/616,950, as well as the suitability of the compounds to control *Pseudocercospora* *harpotrichoides* in crop plants which properly results from the particular structure of the benzophenones of the formula (I), were already well within the purview of a person working in the field of fungicidal ingredients in view of the prior art teachings.

I cannot share the Examiner's position as set forth in the Office action of September 29, 2004, for the following reasons. As is the case in all technical areas concerned with biologically active compounds a person working in the field of fungicides might expect that compounds having a similar or at least a comparable chemical structure act similarly or at least exhibit an effect of a comparable order of magnitude. However, this is not the case where the control of *Pseudocercospora* *harpotrichoides* in crop plants with benzophenone compounds is concerned.

To illustrate that even seemingly minor variations in the structure of the benzophenones have a significant and unexpected effect on the effectivity of the benzophenone compound against *Pseudocercospora* *harpotrichoides* in crop plants the following benzophenone compounds



were formulated in a stock solution as follows:

6. JUN. 2005 14:41

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749 021-0021/10

NR. 2769 S. 4

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A solution of 25 mg of the benzophenone compound was extended to 10 ml with a 99:1 per volume solvent/emulgator mixture containing acetone as the solvent and Uniperol® EL (wetting agent having emulsifying and dispersing action based on ethoxylated alkylphenols) as the emulgator. The 10 ml sample was further extended with water to 100 ml, and the 100 ml sample was then diluted with a mixture of the solvent, the emulgator and water to give the desired concentration.

The activity of the benzophenone compounds against *Pseudocercospora herpotrichoides* in wheat plants was investigated by applying the resulting solution to leaves of potted wheat seedlings cv. "Monopol", inoculating the treated wheat plants and assessing the extent of the development of the infection in the manner described on page 9, indicated line 35, to page 10, indicated line 2, of the application. The results are summarized in the following table:

Benzophenone Compound	Application Rate [ppm]	Fungal Attack [%]
Example I.1	16	19
Comparative Compound	16	56
untreated control		90

The data show that 16 ppm of the benzophenone Example I.1 according to formula (I) of application Serial No. 10/616,950 reduced the *Pseudocercospora herpotrichoides* infection from 90% of the control experiment to 19%. When the same amount of the Comparative Compound was applied, the tested plants still exhibited 56% *Pseudocercospora herpotrichoides* infection.

I find nothing in the disclosure of either one of the references which were applied by the Examiner in the Office action dated September 29, 2004, which suggests or implies that benzophenones which are seemingly structurally closely related exhibit significantly different effects when the compounds are employed to control *Pseudocercospora herpotrichoides* infections in crop plants. In my opinion the superior activity of the compounds of formula (I) of application Serial No. 10/616,950 which is evident from the data shown above could not have been foreseen.

In my opinion the data corroborate that a person working in the field of fungicidal ingredients could not reasonably expect, based on the prior art teachings applied by the Examiner, that the benzophenones

6. JUN. 2005 14:42

REITSTOETTER, KINZEBACH & PARTNER
797 021 002110

NR. 2769 S. 5

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AB200540

which are represented by formula (I) of application Serial No. 10/616,950 would achieve results in the control *Pseudocercospora herpotrichoides* in crop plants which are distinctly better than the results which are obtained with benzophenone compounds which are structurally closely related but which are outside of the realm of formula (I).

I further declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed at 67056 Ludwigshafen, this 6th day of June 2005.



(Signature of Declarant)

16. JAN. 2006 18:16

REITSTOETTER, KINZEBACH & PARTNER

NR. 9776 S. 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: GEWEHR ET AL.

SERIAL No. 10/616,950

FILED: JULY 11, 2003

FOR: FUNGICIDAL USE

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION

I, Reinhard Stierl, Dr. agr., a citizen of the Federal Republic of Germany and residing at Jahnstr. 8, 67251 Freinsheim, Germany, hereby declare as follows:

I am fully trained agricultural engineer, having studied horticultural science at the Technical University of Munich-Weihenstephan, Germany, from 1987 to 1992;

From 1994 to 1999 I furthered my studies at the Institute of Plant Disease of the University of Bonn, and I was awarded my doctor's degree by the said university in 1999;

I joined BASF Aktiengesellschaft of 67056 Ludwigshafen, Germany, in 1998, and have since been working in the field of the characterization and screening of fungicidal substances, and am therefore fully conversant with the technical field to which the invention disclosed and claimed in application Serial No. 10/616,950 belongs.

Serial No. 10/616,950
GEWHR et al.
AM200040

I have studied the record of application Serial No. 10/616,950, and particularly the Office action mailed on August 19, 2005, and the prior art applied by the Examiner, in particular the teaching of Curtze et al. (US 6,127,570), and the teaching of Sieverding et al. (US 6,696,497).

It is my understanding that the Examiner contends that the particular features of the benzophenones which are represented by formula (I) of application Serial No. 10/616,950, as well as the suitability of the compounds to control *Pseudocercospora herpotrichoides* in crop plants which properly results from the particular structure of the benzophenones of the formula (I), were already well within the purview of a person working in the field of fungicidal ingredients in view of either one of the prior art teachings referenced above.

I cannot share the Examiner's position as set forth in the Office action of August 19, 2005, for the following reasons. Curtze et al. specifically state that benzophenones encompassing the benzophenones of the formula I which are defined in the claims of application Serial No. 10/616,950 are effective against powdery mildew diseases like *Blumeria (Erysiphe) graminis*, *Erysiphe cichoracearum*, *Podosphaera leucotricha*, *Uncinula necator* and the like (see col. 3, lines 19 to 26, of Curtze et al.). It is important to note in this context that all of these pathogens grow on the leaf surfaces. In contrast thereto, the fungus *Pseudocercospora herpotrichoides* which is referenced in the claims of application Serial No. 10/616,950 is a plant pathogen which primarily grows in the plant tissue. Further examples of pathogenic fungi which mainly grow in the plant tissue include *Alternaria solani*, *Botrytis cinerea*, *Fusarium culmorum*, *Phytophthora infestans*, *Plasmopara viticola*, *Puccinia recondita*, *Pyricularia oryzae*, or *Pyrenophora teres*.

It is well known in the fungicidal art that a large number of fungicides which are effective against powdery mildew diseases, i.e. fungal diseases which grow on the surface of leaves, do not provide sufficient control of plant pathogenic fungi which mainly grow in the plant tissue. Examples of such fungicides which only provide control of powdery mildew include dinocap, bupirimate, ethirimol, dimethirimol, pyrazophos, and dodemorph.

16. JAN. 2006 18:17

REITSTOETTER, KINZEBACH & PARTNER

NR. 9776 S. 4

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GEWEHR et al.

AM200040

It is also well known in the fungicidal art that the effectivity of a compound against a fungus that mainly grows in the plant tissue is influenced by a variety of factors and that not all of the factors which have an impact on the said effectivity are known or predictable. Factors which are known to be involved include lipophilicity and solubility of the compound, since these factors affect the uptake of the compound into the plant tissue. Since these factors are important for the properties of the compound within the plant tissue, they do not have a major effect on the control of fungi that live on the plant surfaces. In retrospect, it is sometimes possible to determine which factors are most likely to contribute to a found activity. However, it is frequently even then not possible to explain the activity by these factors and other factors yet unknown may play a role. Therefore it is impossible to predict the activity of compound against a plant dwelling fungus which is known to be active against powdery mildew.

The foregoing general technical background knowledge also holds true where benzophenones in general and the benzophenones of the formula I referenced in the claims of application Serial No. 10/616,950 are concerned. Benzophenones are generally known to be only poorly suited to achieve a satisfactory control of pathogenous fungi that mainly grow in the plant tissue. This is, for example, confirmed by the information available from the teaching of Sieverding et al. The results presented tables 1 and 2 of Sieverding et al. demonstrate that the benzophenone compound BP-4 (5-bromo-2',6-dimethyl-2,4',5',6'-tetramethoxy-benzophenone) exhibits, at the investigated amounts, no or only marginal effectivity against *Plasmopara viticola*, i.e. a fungus which mainly grows in the tissue of the plant. The effectivity of the benzophenones I referenced in the current claims of application Serial No. 10/616,950 against *Pseudocercospora heliotrichoides* therefore constitutes, in my opinion, an exception which could not reasonably be expected based on the information which was available from the teachings of Curtse et al. and of Sieverding et al. when the application was filed.

To further demonstrate that the efficacy of benzophenones against any particular pathogenous fungus that mainly grows in the plant tissue is even less predictable I conducted the following experiments and investigations. The tests were carried out by me or under my supervision. The tests were conducted with the compound of the following formula Ia

16. JAN. 2006 18:17

REITSTOETTER, KINZEBACH & PARTNER

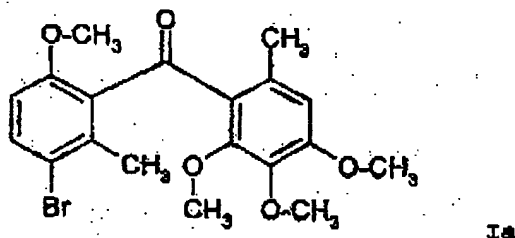
NR. 9776 S. 5/09

747 021 0021110

Serial No. 10/616,950

GEWEHR et al.

AM200040



which was formulated in a stock solution as follows:

A solution of 25 mg of the benzophenone compound was extended to 10 ml with a 99:1 per volume solvent:emulsifier mixture containing acetone and/or dimethylsulfoxid as the solvent and Uniperol® EL (wetting agent having emulsifying and dispersing action based on ethoxylated alkylphenols) as the emulsifier. The 10 ml sample was further extended with water to 100 ml, and the 100 ml sample was then diluted with a mixture of the solvent, the emulsifier and water to give the desired concentration.

The efficacy of the benzophenone compound Ia against different pathogenous fungi that mainly grow in the plant tissue was investigated as follows:

Preventative fungicidal control of early blight on tomatoes (*Alternaria solani*) (ALTESO P1)

Young seedlings of tomato plants were grown in pots. These plants were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The next day, the treated plants were inoculated with an aqueous suspension of *Alternaria solani*. Then the trial plants were immediately transferred to a humid chamber. After 5 days at 20 to 22°C and a relative humidity close to 100 %, the extent of fungal attack on the leaves was visually assessed as a diseased leaf area.

Preventative control of grey mold (*Botrytis cinerea*) on green pepper (BOTICI P1)

Young seedlings of green pepper were grown in pots to the 2 to 3 leaf stage. These plants were sprayed to run-off with an aqueous

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suspension containing 250 ppm of the benzophenone Ia. The next day the treated plants were inoculated with a spore suspension of *Botrytis cinerea* in a 2 % aqueous malt solution. Then the trial plants were immediately transferred to a dark, humid chamber. After 5 days at 22 to 24°C and a relative humidity close to 100 % the extent of fungal attack on the leaves was visually assessed as % diseased leaf area.

Control of culm rot on pearl millet caused by *Fusarium culmorum* (FUSACU P1)

Pot-grown pearl millet seedlings with 2 - 3 true leaves of the variety "Gelbe Kolben-Hirse" were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The plants were allowed to air-dry. On the following day the plants were inoculated with an spore suspension of *Fusarium culmorum* in a 2% aqueous malt solution. Then the trial plants were immediately transferred to a humid chamber. After 6 days at 23-25°C and a relative humidity close to 100 % the extent of fungal attack on the leaves was visually assessed as % diseased leaf area.

Control of late blight on tomatoes caused by *Phytophthora infestans* (PHYTIN P1)

Young seedlings of tomato plants were grown in pots. These plants were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The next day, the treated plants were inoculated with an aqueous suspension of sporangia of *Phytophthora infestans*. After inoculation, the trial plants were immediately transferred to a humid chamber. After 6 days at 18 to 20°C and a relative humidity close to 100 % the extent of fungal attack on the leaves was visually assessed as % diseased leaf area.

Fungicidal control of grape downy mildew caused by *Plasmopara viticola* (PLASVI P1)

Grape cuttings of the cultivar "Müller-Thurgau" were grown in pots to the 4 to 5 leaf stage. These plants were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The next day the treated plants were inoculated with an aqueous spore

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suspension of *Plasmopara viticola* by spraying the suspension at the lower leaf-side. Then the trial plants were immediately transferred for 24 h to a humid chamber with 22 - 24°C and a relative humidity close to 100 % where they were kept for 24 h. Subsequently, the plants were cultivated for a period of 5 days in a greenhouse at 20 - 25°C and a relative humidity about 50-80 %. To stimulate the outbreak of the disease symptoms, the plants were then transferred to a humid chamber again where they were kept for an additional 24 hours. Then the extent of fungal attack on the lower leaf surface was visually assessed as % diseased leaf area.

Curative control of brown rust on wheat caused by *Puccinia recondita* (PUCCRT K1)

The first two developed leaves of pot-grown wheat seedling of the variety "Kanzler" were dusted with spores of *Puccinia recondita*. To ensure the success the artificial inoculation, the plants were transferred to a humid chamber where they were kept for 24 h without light and at a relative humidity of 95 to 99 % and 20 to 22°C. The next day the plants were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The plants were allowed to air-dry. Then the trial plants were cultivated for 8 days in a greenhouse chamber at 22-26°C and a relative humidity between 70 and 80 %. The extent of fungal attack on the leaves was visually assessed as % diseased leaf area.

Preventative fungicidal control of rice blast caused by *Pyricularia oryzae* (PYRIOC P1)

Leaves of pot-grown rice seedling of the variety "Tai-Mong 67" were sprayed to run-off with an aqueous suspension containing 250 ppm of the benzophenone Ia. The plants were allowed to air-dry. On the following day the plants were inoculated with an aqueous spore suspension of *Pyricularia oryzae*. Then the trial plants were immediately transferred to a humid chamber. After 6 days at 22-24°C and a relative humidity close to 100 % the extent of fungal attack on the leaves was visually assessed as % diseased leaf area.

Control of net blotch on barley caused by *Pyrenophora teres*

16. JAN. 2006 18:18

REITSTOETTER, KINZEBACH & PARTNER

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(PYRENTE P1)

The first fully developed leaves of pot grown barley plants were sprayed to run-off with an aqueous suspension, containing 250 ppm of the benzophenone Ia. The next day the treated plants were inoculated with an aqueous spore suspension of *Pyrenophora* (syn. *Drachlera*) *terres*. Then the trial plants were immediately transferred to a humid chamber. After 6 days of cultivation at 20-24°C and a relative humidity close to 100 %, the extent of fungal attack on the leaves was visually assessed as % leaf area.

The activity of the benzophenone compound Ia against *Pseudocercospora herpotrichoides* (PSDCHE P1) in wheat plants was investigated by applying an aqueous suspension, containing 250 ppm of the benzophenone Ia to leaves of potted wheat seedlings cv. "Monopol", inoculating the treated wheat plants and assessing the extent of the development of the infection in the manner described on page 9, indicated line 35, to page 10, indicated line 2, of the application.

The results are summarized in the following table:

fungus	Fungal Attack at 250 ppm of Ia	Fungal Attack in untreated control
ALTEGO P1	100 %	100 %
BOTRICI P1	100 %	100 %
FUSACU P1	90 %	90 %
PHYTIN P1	100 %	100 %
PLASVI P1	90 %	90 %
FUCCRT K1	100 %	100 %
PYRITOR P1	100 %	100 %
PYRENTE P1	100 %	100 %
PSDCHE P1	0%	90%

While powdery mildews grow mainly on the surface of plant leaves, the pathogens listed in the table above after a short infection period on the surface of the leaves (ectophytic life stage), have an endophytic growth within the plant leaves. The results demonstrate that the benzophenone Ia does not sufficiently control the short ectophytic and the following endophytic life stages and thus does not prevent the massive damage of the plants. After the short infection period

16. JAN. 2006 18:18

REITSTOETTER, KINZEBACH & PARTNER

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Pseudocercospora herpotrichoides grows deeply in the stem of cereals and in the leaf layers wrapped around the stem, thereby slowly causing a destruction of the plant tissue over a period of several weeks. During this period the fungus growing in the tissue of the stem is well protected by the leaf layers against environmental influences or direct contact with chemicals. Therefore it was highly surprising that the benzophenones I which are referenced in the claims of application Serial No. 10/616,950 and which are not active against other plant dwelling fungi provide sufficient control of *Pseudocercospora herpotrichoides*.

I find nothing in the disclosure of either one of the references which were applied by the Examiner in the Office action dated August 19, 2005, which suggests or implies that the benzophenones I which are referenced in the claims of application Serial No. 10/616,950 are useful to control *Pseudocercospora herpotrichoides* infections in crop plants.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information or belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 101 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed at 67056 Ludwigshafen, this 16th day of January 2006.


(Signature of Declarant)

Serial No. 10/616,950

GEWEHR et al.

AM200040

APPENDIX III

RELATED PROCEEDINGS APPENDIX

NONE

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